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09/602,964	06/23/2000	Shiro Mazawa	Hitachi-0008	1581

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EXAMINER

QUINONES, ISMAEL C

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 06/09/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/602,964

Applicant(s)

MAZAWA ET AL.

Examiner

Ismael Quiñones

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 8 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29 is/are allowed.
- 6) ☒ Claim(s) 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/12/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on June 23, 2000. **Claims 1-31** are now pending in the present application. **This Action is made FINAL.**

#### *Information Disclosure Statement*

2. The information disclosure statement (IDS) submitted on March 15, 2004 has being considered by the examiner and made of record in the application file.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 30-31** are rejected under 35 U.S.C. 102(e) as being anticipated by Elwin et al. (U.S. Pat. No. 6,148,210).

Regarding **claim 30**, Elwin et al. disclose a terminal usage limiting apparatus; comprising (A cell station who limit the use of operation according to its respective coverage area; *col. 1, lines 32-33; item 12 and item 12b*): a transmitter (Means for communicating with a PCS (Personal Communication System) unit, an example being sending a local identification code (LID); *col. 2, lines 3-6; Figs. 3-4 and 7-8*) for

transmitting a first signal to a mobile terminal in a predetermined area for the mobile terminal to perform a hand-off to the terminal usage limiting apparatus (Registering with the current cell station as it receives a LID; *col. 1, line 66 thru col. 2, line 17*); a receiver for receiving a second signal from the mobile terminal (receiving a registration request signal from a PCS unit or mobile terminal; *col. 2, lines 9-13 and lines 23-25; Figs. 3-4 and 7-8*); an analyzing unit connected to said receiver for analyzing the second signal to determine a call number in response to a call transmission request (A PCS unit sending a connection request signal (Link Channel request) when a user places an outgoing call, wherein said connection request signal is analyzed by the network controller in order to find an emergency indicator, therefore selecting or handing over communications based on the emergency indicator; *col. 10, lines 55-65*); a hand-off directing unit connected to said analyzing unit and said transmitter for generating a third signal indicative of forcing a hand-off of the mobile terminal from the terminal usage limiting apparatus to an adjacent base station if the call number is permissible (Wherein if PCS setup channel signal strength falls below an unacceptable level or if a emergency call is placed, a notification is made by its operative cell to a network controller, subsequently said network controller sends a monitor request signal to other cell stations adjacent to the current operative cell, therefore handing over communications to one of the adjacent cell station; *col. 10, line 55 thru col. 11, line 16*), said transmitter transmitting the third signal to the mobile terminal (The cell station transmitting the conditions for executing hand-off, such as signal deterioration, to the network controller; *col. 2, line 54 thru col. 3, line 7; col. 10, line 55 thru col. 11, line 16*).

Regarding claim 31, and as applied to claim 30, Elwin et al. disclose the aforementioned terminal usage limiting apparatus, wherein said transmitter transmits a fourth signal which prohibits the mobile terminal from transmission (Wherein if none of the conditions for freeing up a voice channel on a cell station are met, the cell station through the network controller sends a message declaring that a call has being blocked; *col. 5, line 66 thru col. 6, line 16*).

***Allowable Subject Matter***

5. Claims 1-5, 7, and 9-29 are allowed, claims are renumbered 1-27, respectively.
6. The following is an Examiner's statement of reasons for allowance:

Consider **claim 1**, the prior art of record fails to teach, disclose or suggest a terminal usage limiting apparatus for temporary use with a mobile terminal communication, comprising: a signal transmitter for transmitting a signal in a predetermined size of an area defining a restricted area where the use of the mobile terminal is restricted, the signal having a characteristic that is substantially indistinguishable from a predetermined characteristics of a base station; a message generator connected to said signal transmitter for generating said signal which includes information identifying the terminal usage limiting apparatus an access channel demodulator for demodulating a signal that is received from the mobile terminal; a message analyzer connected to said access channel demodulator for analyzing the demodulated signal; a restricted phone number memory for storing a predetermined list of phone numbers that are allowed to call in the restricted area; an emergency call

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deciding device connected to said message analyzer and said restricted phone number memory for determining whether or not a requested phone number is an emergency call by comparing the requested phone number to the predetermined list in response to a call origination message from said message analyzer; and a hand-off directing device connected to said emergency call deciding device and said message generator for directing said message generator to generate an emergency call hand-off message to force the mobile terminal to switch from the terminal usage limiting apparatus to an available base station in response to the emergency call, the emergency call hand-off message including base station ID information on the available base station.

The best prior art found during the prosecution of the present application, Park et al. (U.S. Pat. No. 6,490,455) in view of Kaneko (JP 10-304430) disclose to teach, disclose, or suggest a terminal usage limiting apparatus for temporary use with a mobile terminal communication, comprising: a signal transmitter for transmitting a signal in a predetermined size of an area defining a restricted area where the use of the mobile terminal is restricted, the signal having a characteristic that is substantially indistinguishable from a predetermined characteristics of a base station; a message generator connected to said signal transmitter for generating said signal which includes information identifying the terminal usage limiting apparatus an access channel demodulator for demodulating a signal that is received from the mobile terminal; a message analyzer connected to said access channel demodulator for analyzing the demodulated signal; a restricted phone number memory for storing a predetermined list of phone numbers that are allowed to call in the restricted area; an emergency call

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deciding device connected to said message analyzer and said restricted phone number memory for determining whether or not a requested phone number is an emergency call by comparing the requested phone number to the predetermined list in response to a call origination message from said message analyzer

Park et al. in view of Kaneko fail to specifically teach, disclose or suggest a hand-off directing device directing said message generator to generate an emergency call hand-off message to force the mobile terminal to switch from the terminal usage limiting apparatus to an available base station in response to the emergency call.

Consider **claim 13**, the prior art of record fails to teach, disclose or suggest a mobile terminal for use in a restricted use area with a terminal usage limiting apparatus, comprising: a receiver for receiving a signal for wireless communication; a restricted phone number memory unit for storing a list of predetermined emergency numbers; an emergency deciding device connected to said restricted phone number memory unit for determining whether or not a requested phone number is an emergency by comparing the requested phone number to the predetermined emergency numbers; a message generator connected to said emergency deciding device for generating an emergency signal indicative of emergency in response to said emergency deciding device; and a transmitter connected to said message generator for transmitting the emergency signal to the terminal usage limiting apparatus in response to the emergency signal, said receiver receiving information for forcing the mobile terminal to be switched from the terminal usage limiting apparatus to an available base station.

The best prior art found during the prosecution of the present application, Park et al. (U.S. Pat. No. 6,490,455) in view of Kaneko (JP 10-304430), further in view of Pelech et al. (U.S. Pat. No. 6,243,585) disclose to teach, disclose, or suggest a mobile terminal for use in a restricted use area with a terminal usage limiting apparatus, comprising: a receiver for receiving a signal for wireless communication; a restricted phone number memory unit for storing a list of predetermined emergency numbers; an emergency deciding device connected to said restricted phone number memory unit for determining whether or not a requested phone number is an emergency by comparing the requested phone number to the predetermined emergency numbers; a message generator connected to said emergency deciding device for generating an emergency signal indicative of emergency in response to said emergency deciding device; and a transmitter connected to said message generator for transmitting the emergency signal to the terminal usage limiting apparatus in response to the emergency signal.

Park et al. in view of Kaneko, further in view of Pelech et al. fail to specifically teach, disclose or suggest receiving information for forcing the mobile terminal to be switched from the terminal usage limiting apparatus to an available base station.

Consider **claim 20**, the prior art of record fails to teach, disclose or suggest a method of restricting; the use of a mobile terminal in a predetermined area, comprising: determining a unique station information on a terminal usage limiting apparatus for identifying a transmission source; storing a predetermined set of emergency calls; periodically transmitting to the mobile terminal a signal including the unique station information in a predetermined area; receiving a signal from the mobile terminal;



determining whether or not the received signal is a call origination request to one of the predetermined set of emergency calls; forcing the mobile terminal to switch from the terminal usage limiting apparatus to an available base station via hand-off message in response to said determining step; and allowing the mobile terminal to retransmit the call origination request directly to the base station.

The best prior art found during the prosecution of the present application, Park et al. (U.S. Pat. No. 6,490,455) in view of Kaneko (JP 10-304430) disclose to teach, disclose, or suggest a method of restricting; the use of a mobile terminal in a predetermined area, comprising: determining a unique station information on a terminal usage limiting apparatus for identifying a transmission source; storing a predetermined set of emergency calls; periodically transmitting to the mobile terminal a signal including the unique station information in a predetermined area; receiving a signal from the mobile terminal; determining whether or not the received signal is a call origination request to one of the predetermined set of emergency calls.

Park et al. in view of Kaneko fail to specifically teach, disclose or suggest forcing the mobile terminal to switch from the terminal usage limiting apparatus to an available base station via hand-off message in response to said determining step; and allowing the mobile terminal to retransmit the call origination request directly to the base station.

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

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Sixth Floor (Receptionist)

9. Any inquiry concerning this communication on earlier communications from the Examiner should be directed to Ismael Quiñones whose telephone number is (703) 305-8997. The Examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

10. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703) 305-4700 or call customer service at (703) 306-0377.

*Ismael Quiñones*

I.Q

June 1, 2004

*Charles Appiah*  
CHARLES APPIAH  
PRIMARY EXAMINER